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10 UNITED STATES DISTRICT COURT
11 NORTHERN DISTRICT OF CALIFORNIA
12 SAN FRANCISCO DIVISION
13

14 MARK L. MCHUGH, an individual,
15 Plaintiff,
16 v.

17 HILLERICH & BRADSBY CO., a private
company,
18 Defendant.
19

CASE NO. C 07-03677 JSW

**PLAINTIFF MARK L. MCHUGH'S
OPENING CLAIM CONSTRUCTION
BRIEF**

Date: August 26, 2008
Time: 2 p.m.
Judge: Hon. Jeffrey S. White
Courtroom: Courtroom 2, 17th Floor

20 AND RELATED COUNTERCLAIMS.
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TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	OVERVIEW OF THE '091 PATENT	2
III.	ARGUMENT	3
A.	Claim Construction Principles	3
B.	The Four Terms Requiring Construction	4
1.	The plain and ordinary meaning of the term “member” is “component.”	4
a.	<i>H&B’s construction requires the Court to construe the term “comprising” as having no function in the claim.</i>	6
b.	<i>H&B’s construction of member to include a specific length limitation is inconsistent with the intrinsic evidence.</i>	7
c.	<i>The term “resilient” does not require construction.</i>	8
2.	The plain and ordinary meaning of the term “retainer” is “hand grip element for positioning and retaining the member.”	10
a.	<i>H&B’s construction of “retainer” excludes the preferred embodiment claimed in claims 5, 7 and 13.</i>	11
b.	<i>H&B demands the construction of the phrase “connected to the member” but offers no construction thereof.</i>	12
3.	The term “in a gap” refers to a location.	13
4.	The term “attachment” should be construed to mean “glove component which secures the member to the glove.”	17
C.	The Remaining Terms Submitted By H&B Do Not Require Construction.	19
1.	The phrase “adjacent to the base of the user’s fingers” does not require construction.....	19
2.	The phrase “base of the of the user’s fingers” does not require construction.	22
3.	The phrase “includes a plurality of sub-members” does not require construction.....	22
4.	The phrases “retain the member” and “configured to fit” do not require construction.....	24
IV.	CONCLUSION	25

TABLE OF AUTHORITIES

CASES

<i>Altiris, Inc. v. Symantec Corp.</i> ,	
318 F.3d 1363 (Fed. Cir. 2003)	3, 4
<i>CCS Fitness, Inc. v. Brunswick Corp.</i> ,	
288 F.3d 1359 (Fed. Cir. 2002)	4, 5
<i>General American Transportation Co. v. Cryo-Trans, Inc.</i> ,	
93 F.3d 766 (Fed. Cir. 1996)	20
<i>Haworth, Inc. v. Herman Miller, Inc.</i> ,	
37 U.S.P.Q. 2d 1080 (W.D. Mich. 1994)	20
<i>Innova/Pure Water, Inc. v. Safarai Water Filtration Sys., Inc.</i> ,	
381 F.3d 1111 (Fed. Cir. 2004)	3, 10, 14
<i>NTP, Inc. v. Research In Motion, Ltd.</i> ,	
418 F.3d 1282 (Fed. Cir. 2005),	4, 25
<i>Phillips v. AWH Corp.</i> ,	
415 F.3d 1303 (Fed. Cir. 2005)	3, 4, 20
<i>Power Mosfet Tech., LLC v. Siemens AG</i> ,	
378 F.3d 1396 (Fed. Cir. 2004)	7
<i>Renishaw PLC v. Marposs Societa' per Azioni</i> ,	
158 F.3d 1250 (Fed.Cir.1998)	12, 19
<i>SanDisk Corp. v. Memorex Products, Inc.</i> ,	
415 F.3d 1278 (Fed. Cir. 2005)	12
<i>Teleflex, Inc. v. Ficosa N. Am. Corp.</i> ,	
299 F.3d 1313 (Fed. Cir.2002)	3, 4
<i>Transclean Corp. v. Bridgewood Services, Inc.</i> ,	
290 F.3d 1364 (Fed. Cir. 2002)	9
<i>W. Baran, M.D. v. Medical Device Tech., Inc.</i> ,	
519 F.Supp.2d 698 (N.D. Ohio 2007)	5
<i>Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.</i> ,	
442 F.3d 1322 (Fed. Cir. 2006)	23
<i>York Prods., Inc. v. Cent. Tractor Farm & Family Ctr.</i> ,	
99 F.3d 1568 (Fed. Cir. 1996)	24

OTHER AUTHORITIES

<u>Landis on Mechanics of Patent Claim Drafting</u> ,	
Appendix C-5 to C-6.	5

I. INTRODUCTION

Only four terms of U.S Patent No. 5,806,091 (the “‘091 Patent”) require interpretation by the Court. Mark L. McHugh (“McHugh”) offers constructions reflecting each term’s plain and ordinary meaning. In contrast, Hillerich & Bradsby Co. (“H&B”) demands the interpretation of countless terms and requests the Court’s adoption of constructions that deviate, without support, from these terms’ plain meaning. In some constructions, H&B imports preferred embodiments as claim limitations. In some constructions, H&B excludes expressly claimed embodiments. In all cases, H&B’s proposed constructions violate clear claim construction principles.

H&B’s construction of claim 1 illustrates H&B’s general approach to claim construction. In claim 1, H&B demands the construction of roughly half the words in the claim and replaces terms that have a plain and ordinary meaning with excerpts from the specification that might help create a non-infringement position. H&B’s suggests a complete reconstruction of claim 1, which would read as follows:

A hand grip ~~[configured to fit]~~ ***designed to fit*** in a user’s hand and for use with a handled instrument, comprising:

~~[an elongated resilient member]~~ ***a long and narrow grip having a length greater than three times an average width made of plastic, rubber, or other flexible material that extends across two or more fingers*** having an average width of approximately 4-15 mm and an average thickness of approximately 1-10 mm and ~~[configured to fit]~~ ***designed to fit*** ~~[at a base of the user’s fingers]~~ ***the location where the palm joins the fingers*** ~~[in a gap between a palm of the user’s hand and the base of the user’s fingers]~~ ***filing the space or void above the palm of the hand and below the base of the fingers to prevent the superficial transverse metacarpal ligament, associated tissue, and skin of the palm extending over the base of the fingers when a handle is grasped;*** and

~~[a retainer connected to the member]~~ ***an elastic band, strap or T-shaped brace connected to the grip*** and configured to extend around to the backside of at least one of the user’s fingers ~~[to retain the member]~~ ***to hold or secure the grip*** in the user’s hand ~~[adjacent to the base of the user’s fingers]~~ ***below the base of the user’s fingers.***

The unnecessary and unsupported constructions of H&B should be rejected in favor of the plain and ordinary meaning of the claim terms as proposed in McHugh’s constructions.

II. OVERVIEW OF THE '091 PATENT

The '091 Patent, titled "Hand Grip Aid," issued on September 15, 1998. The '091 Patent is directed to devices that help prevent hand damage (such as blisters and calluses) and discomfort when a person uses sports equipment, exercise equipment, manual work equipment and any other equipment that has a handle. '091 Patent, 1:6-16. One advantage of the invention is that hand damage and discomfort is reduced while a good tactile feel and a strong grip are provided. *Id.*, 1:57-59. Another advantage is that the invention can be worn with or built directly into a glove. *Id.*, 1:59-63, 4:66-5:2. Indeed, the specification describes various glove embodiments, and claims 5, 7 and 13-15 expressly claim specific glove embodiments. *Id.*, 2:13-2:17, 3:52-56; 4:31-44, 4:64-5:2; 5:35-47; 5:56-59, 6:4-14.

There are two components to the hand grip aid claimed in the '091 Patent: (1) a member and (2) a retainer. *See id.*, 5:11-6:14 (claim 1 and its dependent claims). The first component – the member – has specific dimensions for width and thickness and is configured to fit at a specific location in the fingers. *Id.* The '091 Patent claims various embodiments of the member. These claimed embodiments include, for example: a member with a plurality of undulations and protuberance to fit between a user's fingers (claim 2); a member with a plurality of undulations and protuberance to fit between less than four of a user's fingers (claim 3); an inflatable member (claims 8, 10 and 14); an inflatable member with a pump (claims 9, 11 and 15); and a plurality of sub-members (claim 12). *See id.*, 5:22-31; 5:46-59, 6:-14.

The second component – the retainer – is connected to the member and configured to fit around the backside of a user finger or fingers and retain the member at the specific location in the fingers. In addition to claiming a retainer generally (*see* claim 1 of the '091 Patent), specific types of retainers are expressly claimed in the dependent claims. These expressly claimed retainer embodiments include: an elastic strap (claims 4 and 6); and a glove (claims 5, 7 and 13). *Id.*, 5:32-47, 6:4-8.

In this litigation, McHugh has asserted four claims against H&B's Bionic Gloves:

- independent claim 1, which claims a hand grip comprising a member and retainer;
- claim 5 (depends from claim 1), which claims a hand grip comprising a member and a retainer,

1 wherein the retainer is a glove;

- 2 • claim 12 (depends from claim 1), which claims a hand grip comprising a member and a retainer,
3 wherein the member includes a plurality of sub-members; and
- 4 • claim 13 (depends from claim 12), which claims a hand grip comprising a member and a
5 retainer, wherein the member includes a plurality of sub-members and the retainer is a glove
(i.e., a glove with a plurality of sub-members).

6 **III. ARGUMENT**

7 **A. Claim Construction Principles**

8 A court's "claim construction analysis must begin and remain centered on the claim
9 language itself, for that is the language that the patentee has chosen to particularly point out and
10 distinctly claim the subject matter which the patentee regards as his invention." *Innova/Pure Water,*
11 *Inc. v. Safari Water Filtration Sys., Inc.*, 381 F.3d 1111, 1116 (Fed. Cir. 2004)(internal quotations
12 and citations omitted). The "ordinary meaning" is "the meaning that the term would have to a
13 person of ordinary skill in the art in question at the time of the invention." *Phillips v. AWH Corp.*,
14 415 F.3d 1303, 1313 (Fed. Cir. 2005). The written description, the drawings, and the prosecution
15 history provide context and clarification regarding the intended meaning of the claim terms.
16 *Teleflex, Inc. v. Ficosa N. Am. Corp.*, 299 F.3d 1313, 1324-25 (Fed. Cir. 2002). Dictionaries may
17 also play a role in the determination of the plain and ordinary mean of a claim term. *See Phillips*,
18 415 F.3d at 1322 ("Dictionaries or comparable sources are often useful to assist in understanding
19 the commonly understood meanings of words").

20 "Essentially, claim terms take on their ordinary and accustomed meanings unless the
21 patentee demonstrated an intent to deviate from that meaning." *Altiris, Inc. v. Symantec Corp.*, 318
22 F.3d 1363, 1370 (Fed. Cir. 2003) (quoting *Teleflex*, 299 F.3d at 1327). An intent to deviate from a
23 term's ordinary meaning can generally only be shown if: (1) "the patentee acted as his own
24 lexicographer and clearly set forth a definition of the disputed claim term in either the specification
25 or prosecution history; (2) "the patentee distinguished that term from prior art on the basis of a
26 particular embodiment, expressly disclaimed subject matter, or described a particular embodiment
27 as important to the invention"; or (3) "the term chosen by the patentee so deprives the claim of
28 clarity as to require resort to the other intrinsic evidence for a definite meaning." *Id.*, (quoting *CCS*

1 *Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67 (Fed. Cir. 2002).

2 Another basic precept of claim construction—one violated frequently in H&B’s proposed
 3 constructions—is that limitations from the specification (such as from the preferred embodiment)
 4 may not be read into the claims, absent the inventor’s express intention to the contrary. *Teleflex*,
 5 299 F.3d at 1326; *see also CCS Fitness*, 288 F.3d at 1366 (“[A] patentee need not ‘describe in the
 6 specification every conceivable and possible future embodiment of his invention.’”)(internal
 7 citation and quotation omitted). “[A]lthough the specification often describes very specific
 8 embodiments of the invention, we have repeatedly warned against confining the claims to those
 9 embodiments.” *See Phillips*, 415 F.3d at 1323. To protect against this result, a court’s focus should
 10 remain on understanding how a person of ordinary skill in the art would understand the claim
 11 terms. *Id.*

12 **B. The Four Terms Requiring Construction**

13 McHugh believes that only four terms require construction by the Court: (1) member; (2)
 14 retainer; (3) attachment; and (4) in a gap. H&B has proposed additional terms for construction by
 15 the Court; however, such terms reflect their plain and ordinary meaning and do not require
 16 construction. Indeed, claim construction is not meant to be an academic exercise in which a court
 17 pronounces the meaning of every aspect of a patent claim at issue. Instead, “claim construction is a
 18 matter of resolution of disputed meanings and technical scope, to clarify and when necessary to
 19 explain what the patentee covered by the claims, for use in the determination of infringement. It is
 20 not an obligatory exercise in redundancy.” *NTP, Inc. v. Research In Motion, Ltd.*, 418 F.3d 1282,
 21 1311 (Fed. Cir. 2005), *cert. denied*, 126 S. Ct. 1174 (U.S. 2006) (*citing U.S. Surgical Corp. v.*
 22 *Ethicon, Inc.*, 103 F.3d 1554, 1568 (Fed. Cir. 1997)(emphasis added).

23 **1. The plain and ordinary meaning of the term “member” is “component.”**

24 The term “member” appears in claims 1, 5, 12 and 13 of the ‘091 Patent. The following
 25 chart compares the parties’ constructions.

1	McHugh's Construction	Actual Language	H&B's Construction
2	component	member	a grip having a length greater than three times an average width made of plastic, rubber, or other flexible material that extends across two or more fingers ¹

3
4
5 The term “member” is a common term of art in patent claims. Indeed, Landis notes that
6 “member” is a general term for a structure as commonly found in the vocabulary used in the
7 mechanical arts and patents. *See Landis on Mechanics of Patent Claim Drafting*, Appendix C-5 to
8 C-6.

9
10 Courts have agreed. For example, in *CCS Fitness Inc. v. Brunswick Corp.*, the court stated
11 that “member” refers to a “structural unit” or a “distinct part of a whole.” *CCS Fitness*, 288 F.3d at
12 1367 (citing McGraw-Hill Dictionary of Scientific and Technical Terms, 1237 (5th ed. 1994);
13 American Heritage Dictionary 849 (3d ed. 1996)); *see also W. Baran, M.D. v. Medical Device*
14 *Tech., Inc.*, 519 F.Supp.2d 698, 714 (N.D. Ohio 2007) (defining “member” as “a constituent part of
15 a whole . . . an essential part of a framed structure, a machine, or a device. . . a part of a whole”).
16 The court in *CCS Fitness* resultantly held that “‘member’ denotes a beam-like structure that is ‘a
17 single unit in a larger whole’” and noted that an accused infringer “cannot use the intrinsic
18 evidence’s silence to narrow the ordinary meaning of an unambiguous claim.” *CCS Fitness*, 288
19 F.3d at 1367-68. On the face of the claims, McHugh’s construction of “member” to mean
20 “component” is consistent with its general use in claim drafting.

21 The intrinsic evidence supports the application of McHugh’s construction. Indeed, the
22 intrinsic evidence does not demonstrate any intent to deviate from the ordinary and accustomed
23 meaning of “member.” The term “member” appears in claims 5, 12 and 13 on an antecedent basis
24 in reference to claim 1, which reads:

25
26 ¹ H&B’s construction is for the phrase “elongated resilient member,” not just “member.” Despite
27 the parties’ good faith efforts to comply with Judge White’s Standing Order on Patent Cases, the
28 parties were unable to agree on the identity of all terms required for construction. Where
applicable, this disagreement is noted and discussed in turn. Although McHugh asserts that term
“elongated” does not require construction, he withdraws his ‘if necessary’ construction. As such,
the term “elongated” is not addressed here.

1 A hand grip configured to fit in a user's hand and for use with a handled
instrument, *comprising*:

2 an elongated resilient **member** having an average width of approximately
3 4-15 mm and an average thickness of approximately 1-10 mm and configured to
4 fit at a base of the user's fingers in a gap between a palm of the user's hand and
the base of the user's fingers; and

5 a *retainer* connected to the member and configured to extend around to
the backside of at least one of the user's fingers to retain the member in the user's
6 hand adjacent to the base of the user's fingers.

7 '091 Patent, 5:11-21 (claim 1) (emphasis added to evidence that a member is a component
8 comprising a part of the grip). The term "member" is a structure defined by the express claim
9 language that follows it. The "member" in claim 1 is defined as having specific width and
10 thickness dimensions ("having an average width of approximately 4-15 mm and an average
11 thickness of approximately 1-10 mm") and location ("configured to fit at a base of the user's fingers
12 in a gap between a palm of the user's hand and the base of the user's fingers"). *See id.* This express
13 claim language supports the construction of member to mean "component," and the claims do not
14 evidence any intent to deviate from this plain and ordinary meaning.

15 An intent to deviate is not found anywhere in the intrinsic evidence. The term "member"
16 appears sixteen times in the specification. With regard to each reference, McHugh did not "clearly
17 set forth a definition of the disputed claim term" that would demonstrate an intent to deviate from
18 the plain and ordinary meaning of "member" as a component of a hand grip. *See Altiris*, 318 F.3d at
19 1370. The prosecution history provides no such intent either— via a definition of the term,
20 disclaiming subject matter or describing a particular embodiment as important to the invention.

21 Accordingly, the Court should construe the term "member" to mean: **"component."**

22 *a. H&B's construction requires the Court to construe the term*
23 *"comprising" as having no function in the claim.*

24 As noted in Section III(B)(1) *supra*, the hand grip claimed in '091 Patent *must* comprise two
25 elements: (1) a member; and (2) a retainer. *See* '091 Patent, 5:11-21 (claim 1) ("A hand grip . . .
26 *comprising*: [a] member . . .; *and* a retainer")(emphasis added). "'Comprising', while permitting
27 additional elements not required by a claim, does not remove the limitations that are present."
28 *Power Mosfet Tech., LLC v. Siemens AG*, 378 F.3d 1396, 1409 (Fed. Cir. 2004) (emphasis added).
H&B improperly construes "member" to mean "grip" and effectively removes the second claimed

1 limitation of claim 1 (i.e., the retainer). Indeed, if “grip” and “member” can be used
 2 interchangeably as proposed by H&B, the retainer component of claim 1 becomes optional. H&B’s
 3 circular construction is improper and should be rejected for this reason.

4 *b. H&B’s construction of member to include a specific length*
 5 *limitation is inconsistent with the intrinsic evidence.*

6 The express language of claim 1 does not require a specific length limitation. As noted
 7 *supra* in Section III(B)(1), the term “member” is expressly defined by the claim language as having
 8 specific width and thickness dimensions. *See* Section III(B)(1); *see also* ‘091 Patent, 5:11-21
 9 (claim 1)(“ an elongated resilient member having an average width of approximately 4-15 mm and
 10 an average thickness of approximately 1-10 mm”). A specific length limitation is notably absent
 11 from the claims.

12 The express language of the specification similarly does not require a specific length
 13 limitation. Indeed, H&B seeks to add this limitation based on the following description of the
 14 preferred embodiments of Figures 2A and 2B:

15 Exemplary embodiments are described herein with reference to specific
 16 configurations. . . . A first embodiment is described with reference to FIGS. 1-2. .
 17 . . FIGS. 2A-B depict an embodiment of a grip . . . In this aspect of the invention,
 18 as shown in FIGS. 2A-B, grip 20 is an elongated member that has a total length
 19 greater than three times an average thickness and greater than three times an
 20 average width.

21 ‘091 Patent, 2:24-25, 2:29-30, 2:43, 3:10-13. The specification expressly states, however, that “the
 22 grip can be made to *any* total length that is consistent with human hands.” ‘091 Patent, 3:6-7
 23 (emphasis and underlining added). The specification further notes that Figures 2A and 2b are not
 24 limitations of the invention:

25 **Another embodiment is depicted in FIG. 4, where grip 40 is shorter than grip**
 26 **20 shown in FIGS. 2A-B. In some cases, the user may wish a grip to fit next**
 27 **to one, two, or three fingers rather than four.** . . . This embodiment may be
 28 useful where a handle grip area is particularly small and where only a small grip
 30 can be accommodated. An example is a golf club, where only three fingers
 may grip the handle such as in an interlocking grip.

‘091 Patent, 4:19-28 (emphasis and underlining added). In short, the specification contradicts
 H&B’s proposed construction.

Further, McHugh specifically abandoned a specific length limitation – the same limitation

1 that H&B now seeks to revive via its construction – during the prosecution of the ‘091 Patent. A
 2 specific length limitation was proposed during prosecution; however, such language was rejected
 3 by the Examiner and expressly abandoned by the patentee in favor of specific dimensions for
 4 thickness and width. *See* ‘091 Patent File Wrapper, Amendment after Non-Final Rejection, p.1,
 5 06/12/96; *cf. id.*, Preliminary Amendment to Continued Prosecution Application, p.1 (claim 1),
 6 12/01/97.² Indeed, the first amendment to claim 1 of the Continued Prosecution Application reads
 7 as follows:

8 A hand grip configured to fit in a user’s hand and for use with a handled
 9 instrument, comprising:

10 an elongated resilient member having average width of approximately 4-
 11 15 mm and an average thickness of approximately 1-10 mm and configured to fit
 12 at a base of the users fingers in a gap between a palm of the user’s hand and the
 13 base of the user’s fingers; and

14 a retainer connected to the member and configured to extend around to the
 15 backside of at least one of the user’s fingers to retain the member in the user’s
 16 hand adjacent to the base of the user’s fingers.

17 *Id.*, Preliminary Amendment to Continued Prosecution Application, p.1 (claim 1), 12/01/97.

18 The abandonment of the length limitation in favor of specific width and thickness
 19 dimensions was in response to the Examiner’s comments in an August 12, 1997 Examiner
 20 Interview that “recitation of the specific dimensions of the hand grip” (i.e., “having average width
 21 of approximately 4-15 mm and an average thickness of approximately 1-10 mm”) would define
 22 patentable subject matter over the prior art. *See id.*, Amendment After Final Rejection, p.3,
 23 8/19/1997; *see also* ‘091 Patent File Wrapper, 8/12/97 Examiner Interview Summary Record.³ In
 24 sum, H&B’s addition of a specific length limitation is inconsistent with the intrinsic evidence, and
 25 H&B’s construction should be rejected for this reason.

26 c. ***The term “resilient” does not require construction.***

27 The term “resilient” reflects the plain and ordinary meaning intended by the patentee and
 28 does not require construction. H&B improperly seeks to narrow the claims by limiting the member

² Attached as Exhibit 10 and 12, respectively, to McHugh’s Evidence in support of McHugh’s Opening Claim Construction Brief (“McHugh’s Evidence”).

³ Attached as Exhibit 9 and 11, respectively, to McHugh’s Evidence.

1 to being “made of plastic, rubber, or other flexible material.” H&B’s construction does not offer a
 2 definition for “resilient;” rather, it merely replaces the term “resilient” with narrower language
 3 cherry picked from the specification.

4 The term “resilient” has a plain and ordinary meaning that is well known in the art. For
 5 example, in *Transclean Corp. v. Bridgewood Services, Inc.*, the court stated that the term “resilient”
 6 encompasses “that which returns to its original shape following a deformation in shape.”
 7 *Transclean Corp. v. Bridgewood Services, Inc.* 290 F.3d 1364, 1374-75 (Fed. Cir. 2002) (citing
 8 *McGraw-Hill Dictionary of Scientific and Technical Terms* 1693 (5th ed. 1994); *American Heritage*
 9 *Dictionary* 1535 (3rd ed. 1992)). Indeed, there are generally no alternative meanings for “resilient.”
 10 See e.g., *American Heritage Dictionary* 1484 (4th ed. 2000) (“resilient” defined as “capable of
 11 returning to an original shape or position, as after having been compressed”); *Webster’s Third New*
 12 *International Dictionary, Unabridged*, 1932 Merriam-Webster (2002) (“resilient” defined as
 13 “returning freely to a previous position, shape or condition”); *Webster’s Encyclopedic Unabridged*
 14 *Dictionary of the English Language* 867 (1996) (“resilient” defined as “tending to recover readily
 15 from fatigue or depression”); *New Oxford American Dictionary of English* 1441 (2nd ed. 2005)
 16 (“resilient” defined as “able to recoil or spring back into shape after bending, stretching, or being
 17 compressed”).⁴

18 Replacing the term “resilient” with the requirement that the member be “made of plastic,
 19 rubber, or other flexible material” is improper. The specification expressly states that “[a]ny type
 20 of resilient material, such as plastic or rubber, can be used for the invention.” ‘091 Patent, 2:64-65
 21 (emphasis added). The specification further describes various additional embodiments of resilient
 22 members. See *id.*, 3:63-4:18 (describing a molded member); *id.*, 4:45-63 (describing a glove
 23 incorporating a plurality of sub-members). The specification rejects H&B’s cherry-picked
 24 limitation that “resilient members” requires that the member be limited to being “made of plastic,
 25 rubber, or other flexible material.” H&B’s construction should be rejected for this reason.

26 In the event that “resilient” requires construction, McHugh proposes an alternative
 27 _____

28 ⁴ Attached as Exhibit 3 to McHugh’s Evidence.

construction of “resilient” to mean “elastic.” The term “elastic” denotes the elastic properties of a resilient member’s ability to return to its original shape following a deformation in shape. The term “flexible” fails to provide for this ability to return to an original shape. Accordingly, McHugh asserts that the term “resilient” does not require construction; and if any construction were provided, the term “resilient” should be construed to mean: “elastic.”

2. The plain and ordinary meaning of the term “retainer” is “hand grip element for positioning and retaining the member.”

The term “retainer” appears in claims 1, 4-7 and 13 of the ‘091 Patent. The following chart compares the parties’ constructions.

McHugh’s Construction	Actual Language	H&B’s Construction
hand grip element for positioning and retaining the member	retainer	an elastic band, strap or T-shaped brace

The express claim language surrounding the term “retainer” defines what the term means. *See Innova/Pure Water*, 381 F.3d at 1116 (“claim construction analysis must begin and remain centered on the claim language itself, for that is the language that the patentee has chosen to particularly point out and distinctly claim the subject matter which the patent regards as his invention.”) (internal quotations and citations omitted).

Here, the express language of the claims compels the construction of the general structure “retainer” to mean “hand grip element for positioning and retaining the member.” Claim 1, in pertinent part, reads:

a **retainer** connected to the member and configured to extend around to the backside of at least one of the user's fingers to **retain the member in the user's hand** adjacent to the base of the user's fingers.

‘091 Patent, 5:11-21 (claim 1) (emphasis added). The express language of the claim defines “retainer” as a “hand grip element for positioning and retaining the member.” Dependent claims 4-7 and 13 of the ‘091 similarly compel the adoption of McHugh’s construction. Those dependent claims relate to specific embodiments of a retainer, including a glove embodiment and an elastic strap embodiment, which are simply “hand grip elements for positioning and retaining the member.” *See* ‘091 Patent, 5:32-34 (claim 4) (“retainer is an elastic strap”); *id.* 5:35-39 (claim 5)

1 (“the retainer is a glove”); *id.*, 5:40-42 (claim 6)(“the retainer is a elastic strap”); *id.*, 5:43-47 (claim
 2 7) (“the retainer is a glove”); *id.*, 6:4-8 (claim 13) (“the retainer is a glove”). The specification
 3 further compels McHugh’s construction stating:

4 A flexible elastic band retainer 26 is provided to attach to the user's finger *so that*
 5 *the grip 20 will remain in the proper position.*

6 ‘091 Patent, 2:55-57 (emphasis added). In short, the intrinsic evidence supports and compels the
 7 construction of retainer as proposed by McHugh.

8 Accordingly, the Court should construe the term “retainer” to mean: **“hand grip element**
 9 **for positioning and retaining the member.”**

10 *a. H&B’s construction of “retainer” excludes the preferred*
 11 *embodiment claimed in claims 5, 7 and 13.*

12 The adoption of H&B’s construction will quite improperly result in the exclusion of a
 13 preferred and claimed embodiment – where the retainer is a glove. For obvious reasons, H&B
 14 hopes to exclude the glove embodiment claimed expressly in dependent claims 5, 7 and 13 via its
 15 construction of “retainer” to mean “an elastic band, strap or T-shaped brace” in order to escape
 16 direct infringement by H&B’s Bionic Glove Series. The claimed and preferred embodiments of
 17 dependent claims, 5, 7 and 13 that are excluded by H&B’s construction of “retainer” read as
 18 follows:

19 Claim 5

20 A hand grip as in claim 1, wherein:

21 **the retainer is a glove** configured to secure around the user's fingers and
 22 including an attachment to retain the elongated member in a position adjacent to
 23 the base of the user's fingers. (‘091 Patent, 5:35-39 (emphasis added).)

24 Claim 7

25 A hand grip as in claim 2, wherein:

26 **the retainer is a glove** configured to secure around the user's fingers and
 27 including an attachment to retain the elongated member in a position adjacent to
 28 the base of the user's fingers. (‘091 Patent, 5:43-47 (emphasis added).)

Claim 13

A hand grip as in claim 12, wherein:

the retainer is a glove configured to secure around the user's fingers and
 including an attachment to retain the elongated member in a position adjacent to
 the base of the user's fingers. (‘091 Patent, 6:4-8 (emphasis added).)

The specification refers to these expressly claimed glove embodiments, noting that “if desired, grip

20 can be made without band 26” and stating:

Another advantage of the invention is that it can be worn with a glove or without a glove and still achieve the same beneficial results or built directly into a glove or part of a glove for ease of use and convenience. . . .

Grip 20 may be used adhered to, attached to, or not attached to the user's hand. Grip 20 may also be used with a glove, if desired. . . .

Another embodiment is depicted in FIG. 5A, where a glove 50 [i.e., the retainer] includes an attachment 52 for a hand grip 20.

‘091 Patent, 1:59-62; *id.*, 2:63; *id.*, 3:52-56; *id.*, 4:31-44; *id.*, 4:64-5:2.

The specification further states:

A flexible elastic band retainer 26 is provided to attach to the user's finger *so that the grip 20 will remain in the proper position*. Although an elastic band is shown, **any similar type retainer can be used to attach to the user**, such as a velcro strap or a non-elastic strap. A T-shaped brace retainer is also envisioned where the base of the T is attached to the grip 20 and the brace fits between the middle finger and ring finger.

‘091 Patent, 2:55-62 (emphasis added). This reference to a retainer as “an elastic band” or “any similar type retainer” evidences the retainer is a general structure and should not be limited solely to the preferred embodiments – excluding the glove embodiment – described in the specification, as proposed by H&B. *See Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1250 (Fed.Cir.1998) (“if an apparatus claim recites a general structure without limiting that structure to a specific subset of structures, we will generally construe the term to cover all known types of that structure.”).

Adopting H&B’s construction will result in excluding a preferred *claimed* embodiment and unnecessarily limiting claims to other disclosed embodiments.. The Federal Circuit strongly disfavors such claim constructions, declaring them “rarely correct.” *See SanDisk Corp. v. Memorex Products, Inc.*, 415 F.3d 1278, 1285 (Fed. Cir. 2005) (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed.Cir.1996)). For this reason, H&B’s construction should be rejected.

b. H&B demands the construction of the phrase “connected to the member” but offers no construction thereof.

H&B requests the construction of the entire phrase “a retainer connected to the member,” not just “retainer.” Despite this request, H&B has not offered a new construction for “connected to

the member.” Indeed, H&B has simply construed the phrase “connected to the member” as “connected to the grip.” This construction offers nothing other than H&B’s reassertion of its construction of the term “member” to mean “grip,” which was addressed in detail *supra* in Section III(B)(1)(a). As such, McHugh does not address it here.

3. The term “in a gap” refers to a location.

The term “in a gap” appears in claims 1 and describes the location of the member in a user’s fingers. Claim 1 reads, in pertinent part:

an elongated resilient member having an average width of approximately 4-15 mm and an average thickness of approximately 1-10 mm and configured to fit at a base of the user's fingers ***in a gap*** between a palm of the user's hand and the base of the user's fingers

‘091 Patent, 5:11-17 (emphasis added). The crux of the dispute between the parties relates to the purpose of this term. McHugh construes “in a gap” to refer to the appropriate location in the hand. In contrast, H&B construes the term to refer to a particular result. The following chart compares the parties’ constructions.

McHugh’s Construction	Actual Language	H&B’s Construction
in the proximal digital crease of the user’s hand	in a gap	filling the space or void above the palm of the hand and below the base of the fingers to prevent the superficial transverse metacarpal ligament, associated tissue, and skin of the palm extending over the base of the fingers when a handle is grasped ⁵

McHugh’s construction of “in a gap” to refer to a location is consistent with and compelled by the express language of claim 1. *See Innova/Pure Water*, 381 F.3d at 1116 (“claim construction analysis must begin and remain centered on the claim language itself, for that is the language that the patentee has chosen to particularly point out and distinctly claim the subject matter which the patent regards as his invention.”) (internal quotations and citations omitted). The express language of claim 1 requires that the member is configured to fit as a specific location in a user’s fingers.

⁵ H&B’s construction is for the phrase “in a gap between a palm of the user’s hand and the base of the user’s fingers,” not just “in a gap.”

1 '091 Patent, 5:11-21 (claim 1) ("an elongated resilient member . . . configured to fit at a base of the
2 user's fingers in a gap between a palm of the user's hand and the base of the user's fingers").

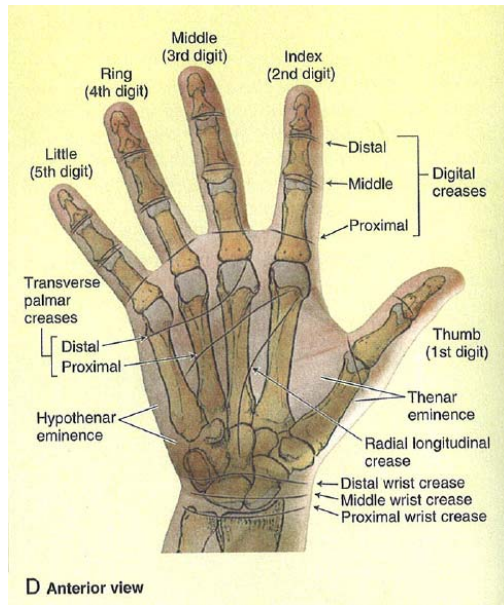
3 The specification describes this "in a gap" location. For example, the specification states:
4 "A hand grip fits in the user's hand near where the palm joins the fingers . . . The member is placed
5 adjacent to the user's fingers and superficial transverse metacarpal ligament." '091 Patent, 1:43-48.
6 The specification further describes this location in relation to specific components of the hand,
7 referring to Figures 1 and 2 for that purpose:

- 8 • "FIG. 1 is a palm view of a human hand showing the metacarpal bones, the
9 phalanges, and the superficial transverse metacarpal ligament."
'091 Patent, 2:1-3.
- 10 • "A first embodiment is described with reference to FIGS. 1-2. FIG. 1 is an
11 illustration of a human hand 10. The hand has a palm region 12 and four
12 fingers 14a-d. The hand 10 includes metacarpal bones (palm bones) 17 and
13 the proximal phalanges (base finger bones) 18. A superficial transverse
metacarpal ligament 16 serves to connect the metacarpal bones 17 near where
14 the proximal phalanges 18 couple with the metacarpal bones 17."
'091 Patent, 2:29-26.
- 15 • "FIGS. 2A-B depict an embodiment of a grip 20 designed to fit adjacent to
16 the ligament 16 and adjacent to the proximal phalanges 18 (the base sections
of finger bones). Note that the grip 20 has one side with an undulating surface
17 22 and one side with a substantially planar surface 24. The undulating surface
22 is designed to accommodate the user's fingers and to fit comfortably in the
18 user's hand 10 adjacent to ligament 16 and the base of fingers 14."
'091 Patent, 2:43-50.

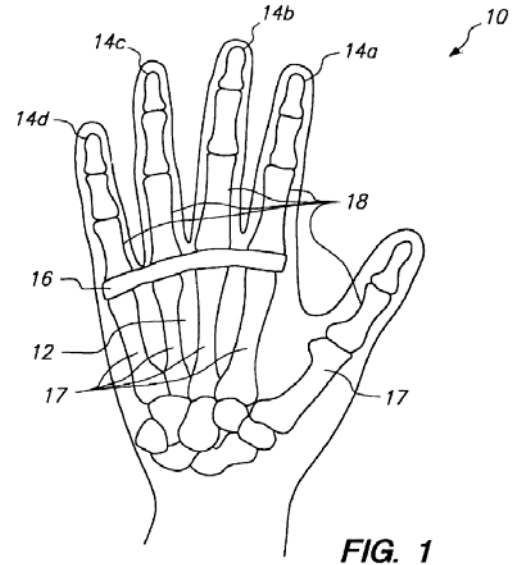
19 In short, the express language of claim 1 and the specification identify the location "in a gap" where
20 the member is configured to fit.

21 McHugh's construction of the term "in a gap" to mean "in the proximal digital crease of the
22 user's hand" reflects this location. Indeed, the proximal digital crease of the hand is the medical
23 term for the crease located at the base of the user's fingers. *See* KEITH L. MOORE, PHD, FIAC,
24 FRSM & ANNE M.R. AGUR, BSc(OT), MSc PHD, ESSENTIAL CLINICAL ANATOMY 470 (Lippincott
25 Williams & Wilkins 3d ed. 2007) (1995) ("The proximal digital crease is located at the root of the
26 digit, approximately 2 cm distal to the metacarpophalangeal joint.").⁶

27 _____
28 ⁶ Attached as Exhibit 7 to McHugh's Evidence.



Id., 470, Fig. D.



'091 Patent, Figure 1.

Physicians, including H&B's nationally renowned orthopedic surgeon, Dr. Kleinert, refer to the gap at the base of the user's fingers as the "crease at the base of the base of the fingers." See U.S. Patent No. 6,389,601 File Wrapper, Affidavit Under Rule 132, p.3-4, 01/07/04 ("[E]ven physicians still often believe that the knuckles on the palm side of the hand are located at the creases at the base of the fingers . . . knuckles, on the palm side of the hand are located at a significant distance, about 3/4", below the crease at the base of the finger.").⁷ McHugh's construction is consistent with and compelled by the express language of the claims and the specification.

H&B's construction is not. First, H&B's construction of the term "in a gap" improperly refers to the function and result of using the grip, not the location for the member in a user's hand. The structural language of claim 1 and its dependent claims mandates that those claims will not be limited by reference to functions described in the specification. *Schwing GmbH. V. Putzmeister Aktiengesellschaft*, 305 F.3d 1318, 1324 (Fed. Cir. 2002) ("where a claim uses clear structural language, it is generally improper to interpret it as having functional requirements). Yet here, H&B ignores the structural language of the claims and construes the phrase "in a gap between a palm of the user's hand and the base of the user's fingers" to mean "filling the space or void above the palm

⁷ Attached as Exhibit 13 to McHugh's Evidence.

1 of the hand and below the base of the fingers to prevent the superficial transverse metacarpal
 2 ligament, associated tissue, and skin of the palm extending over the base of the fingers when a
 3 handle is grasped.”

4 Second, H&B’s language is inconsistent with the actual language of the specification from
 5 which H&B appears to have cherry picked its construction, which reads as follows:

6 One reason the grip 20 is successful is that it fills an unused portion or gap, of the
 7 hand 10 where the ligament 16 and associated tissue would otherwise cause the
 8 skin to overlap over the base of the fingers 14a-d. As shown in FIG. 3, as the hand
 10 grasps a handle 30 with the grip 20 in place, the grip 20 distributes the force of
 the handle 30 over the entire contact surface without an overlap of skin.

9 ‘091 Patent, 3:19-25. H&B seeks to add the limitation that the member component is somehow
 10 “below the base of the fingers.” This addition is unsupported by the intrinsic evidence and intended
 11 to create the non-infringement position that gloves with pads at the base of the fingers do infringe
 12 the ‘091 Patent.

13 The express language of the claims and the physical limitations of the hand refute such a
 14 construction. The requirement that the retainer be “configured to extend around the backside” of a
 15 user’s fingers evidences the physical impossibility of H&B’s construction. Indeed, independent
 16 claim 1 of the ‘091 Patent requires that the “retainer” be “connected to the member and **configured**
 17 **to extend around the backside** of at least one of the user’s fingers.” See ‘091 Patent, 5:11-17 (claim
 18 1); *see also id.*, 5:32-47; 6:4-8 (dependent claims 4, 5, 6, 7 and 13) (emphasis added). The
 19 dependent claims and specification provide various embodiments for the retainer in claim 1,
 20 including an elastic strap, a velcro strap, a T-shaped brace and a glove. See ‘091 Patent, 5:32-34,
 21 5:35-39, 5:40-42, 5:43-47, 6:4-8. With the exception of the glove embodiment, these preferred
 22 embodiments cannot possibly be “configured to extend around the backside” of the fingers (as
 23 required by the claims) and be connected to the member “located below the fingers” (as required by
 24 H&B’s construction).

For example, an elastic strap retainer that is “connected to the member and configured to extend around the backside of at least one of the user’s fingers” cannot physically result in a member located “below the base of the fingers” as posited by H&B. Figure 3 (provided here) graphically illustrates this impossibility. In order for the member to be located below the base of the fingers, the elastic strap retainer would have to pierce through the skin, muscle and bone of the hand. The same is true of the velcro strap and T-shaped bar retainer embodiments.

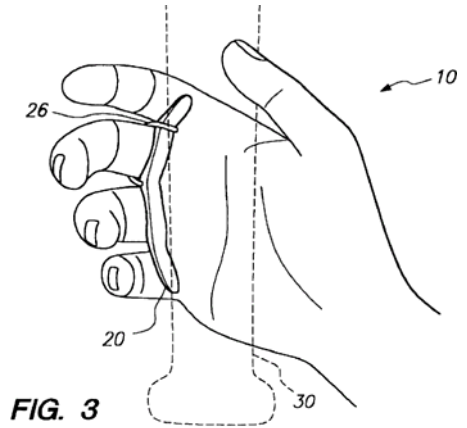


FIG. 3

‘091 Patent, Fig. 3

The “undulations” and “protuberances” dependent claims of the ‘091 Patent further evidence the impossibility of H&B’s construction. *See* ‘091 Patent, 5:22-31 (claims 2 and 3). A member that “has a plurality of undulations *designed to accommodate the user’s fingers* and a plurality of protuberances *designed to fit between the user’s fingers*” cannot physically result in a member located below the base of the fingers as posited by H&B. *See id.*

Lastly, the one preferred retainer embodiment – the dependently claimed glove embodiment – that does not pose a physical impossibility for adopting H&B’s construction, expressly rebukes H&B’s construction. Indeed, the specification states that glove embodiment retains the member in place **over the base of the fingers**, not below the base of the fingers as required by H&B:

Another embodiment is depicted in FIG. 5A, where a glove 50 includes an attachment 52 for a hand grip 20. Glove 50 is constructed so that material is formed over the gap near the base of fingers 14. This material includes attachments 52a and 52b *to hold grip 20 in place over the base of the fingers*.

‘091 Patent, 4:31-36 (emphasis added). H&B construction ignores this express language of the specification in its construction.

The term “in a grip” refers to a location in the hand, and its construction must be compelled and consistent with the language of the claims and specification. Accordingly, the Court should construe the term “in a gap” to mean: “**in the proximal digital crease of the user’s hand.**”

4. The term “attachment” should be construed to mean “glove component which secures the member to the glove.”

The term “attachment” appears in the dependent glove embodiment claims of the ‘091

Patent. *See e.g.*, ‘091 Patent, 5:35-39 (claim 5); *id.*, 6:4-8 (claim 13). The following chart compares the parties’ constructions.

McHugh’s Construction	Actual Language	H&B’s Construction
glove component which secures the member to the glove	attachment	a strap or long thin pocket

The term “attachment” is a structure defined by the express claim language that follows it. *See Innova/Pure Water*, 381 F.3d at 1116. The term “attachment,” as it appears in the glove embodiment claims, “retain(s) the elongated member in a position adjacent to the base of the user’s fingers.” ‘091 Patent, 5:35-39 (claim 5); *id.*, 6:4-8 (claim 13). The specification further supports McHugh’s construction of “attachment” to mean a “glove component which secures the member to the glove,” stating:

Another embodiment is depicted in FIG. 5A, *where a glove 50 includes an attachment 52 for a hand grip 20*. Glove 50 is constructed so that material is formed over the gap near the base of fingers 14. *This material includes attachments 52a and 52b to hold grip 20 in place over the base of the fingers. In FIG. 5, attachments 52a and 52b are elastic straps that retain the grip 20. Alternatively, an attachment can be a single strap, a long thin pocket, or other similar retainer.*

‘091 Patent, 4:31-39 (emphasis added).

In contrast, H&B’s construction improperly limits “attachment” to a very specific subset of structures. As an initial matter, the specification states that that “an attachment can be a single strap, a long thin pocket, *or other similar retainer*.” ‘091 Patent, 4:31-39 (emphasis added). H&B’s construction of “attachment” excludes “other similar retainers”, despite being expressly identified as an embodiment in the specification. The Federal Circuit strongly disfavors such claim constructions, declaring them “rarely correct.” *See SanDisk Corp.*, 415 F.3d at 1285. Moreover, “if an apparatus claim recites a general structure without limiting that structure to a specific subset of structures” as is the case here, courts “will generally construe the term to cover all known types of that structure.” *See Renishaw PLC*, 158 F.3d 1243, 1250 H&B’s construction should be rejected for these reasons.

Accordingly, the Court should construe the term “attachment” to mean: “**glove component which secures the member to the glove.**”

1 **C. The Remaining Terms Submitted By H&B Do Not Require Construction.**

2 H&B submits five additional phrases for construction by the Court. None of these phrases
3 require construction because each reflects their plain and ordinary meaning and there is no evidence
4 of intent to deviate from that meaning. *See Altiris*, 318 F.3d at 1370.

5 **1. The phrase “adjacent to the base of the user’s fingers” does not require**
6 **construction.**

7 H&B tenders its construction of “adjacent to the base of the of the user’s fingers” to mean
8 “below the base of the user’s fingers” solely to establish its position that gloves with pads at the
9 base of the fingers do not infringe the ‘091 Patent. The phrase appears in each of the claims –
10 claims 1, 5, 12 and 13 of the ‘091 Patent – asserted against H&B for direct infringement. H&B’s
11 construction is improper because it deviates from the plain and ordinary meaning of “adjacent”
12 without any intrinsic evidence to support such a deviation.

13 The term “adjacent” has the well-known plain and ordinary meaning of “close to” or “near.”
14 *See General American Transportation Co. v. Cryo-Trans, Inc.*, 93 F.3d 766, 769-70 (Fed. Cir.
15 1996) (discussing the required proximity of a wall “adjacent” to another location); *see also*
16 *Haworth, Inc. v. Herman Miller, Inc.*, 37 U.S.P.Q. 2d 1080, 1085-85 (W.D. Mich. 1994)
17 (construing the bounds of the term “‘adjacent’ as narrowly as ‘next to’ and as broadly as ‘nearby’”
18 and expressly noting that “[t]he word adjacent has well known, common sense, meanings that are
19 not so technical as to require an expert’s interpretation.”). As this ordinary meaning is “readily
20 apparent,” construction of the term “involves little more than the application of the widely accepted
21 meaning.” *Phillips*, 415 F.3d at 1314. Indeed, dictionaries – which are helpful in such instances –
22 provide such definitions. *Id.*, *see e.g.*, *American Heritage Dictionary* 21 (4th ed. 2000)(“adjacent”
23 defined as “close to, lying near”); *Webster’s Third New International Dictionary, Unabridged*,
24 Merriam-Webster (2002) (“adjacent” defined as “to lie near, border on”); *New Oxford American*
25 *Dictionary of English* 1441 (2nd ed. 2005) (“adjacent” defined as “lying near to”).⁸ H&B’s
26 construction does not reflect this plain and ordinary meaning of “adjacent.”

27 _____
28 ⁸ Attached as Exhibit 2 to McHugh’s Evidence.

1 The intrinsic evidence offers no rationale for deviating from this plain and ordinary
 2 meaning. First, H&B’s construction does not find support in the express language of the claims.
 3 Claim 1, for example, reads, in pertinent part:

4 A hand grip . . . , comprising:
 5 an elongated resilient member . . . *configured to fit at a base of the user's*
 6 *fingers* in a gap between a palm of the user's hand and the base of the user's
 7 fingers; and
 8 a retainer connected to the member and configured to extend around to the
 9 backside of at least one of the user's fingers to retain the member in the user's
 10 hand *adjacent to the base of the user's fingers*.

11 ‘091 Patent, 5:11-21 (claim 1) (emphasis added). The member cannot be “configured to fit *at* a
 12 base of the user’s fingers” (as required by the claims) and be required to fit “*below* the base of the
 13 user’s fingers” (as required by H&B’s construction). *See id.*

14 Second, the specification offers no rational for deviating from the plain and ordinary
 15 meaning of “adjacent.” As discussed *supra* in Section III(B)(3) (regarding the term “in a gap”),
 16 constructions that require the member be located below the base of the user’s fingers are expressly
 17 contracted by the specification and, generally, the physical limitations of the hand.

18 The specification states that the glove embodiment retains the member in place **over the**
 19 **base of the fingers**, not below the base of the fingers as required by H&B:

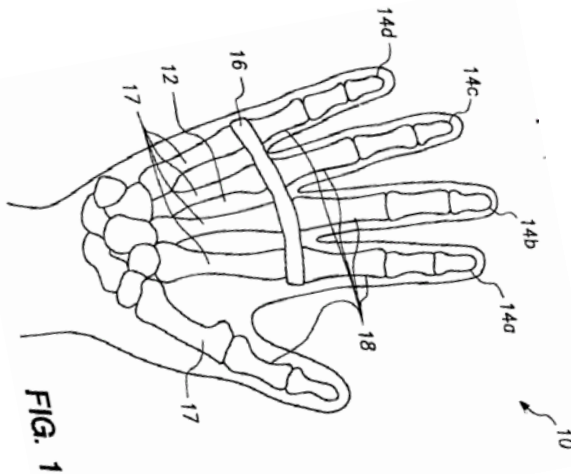
20 Another embodiment is depicted in FIG. 5A, where a glove 50 includes an
 21 attachment 52 for a hand grip 20. Glove 50 is constructed so that material is
 22 formed over the gap near the base of fingers 14. This material includes
 23 attachments 52a and 52b *to hold grip 20 in place over the base of the fingers*.

24 ‘091 Patent, 4:31-36 (emphasis added).

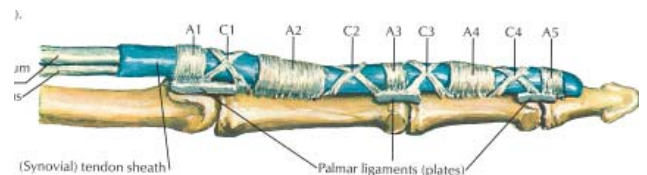
25 The ‘091 Patent further claims and references additional retainer embodiments – such as an
 26 elastic strap, a velcro strap and a T-shaped brace – that would require the retainer to pierce through
 27 the skin, muscle and bone of the hand if H&B’s construction is adopted. *See e.g.*, ‘091 Patent, 5:32-
 28 34, 5:35-39, 5:40-42, 5:43-47, 6:4-8. For example, a T-shaped brace retainer that is “connected to
 the member and configured to extend around the backside of at least one of the user’s fingers”
 cannot “retain the member in the user’s hand” (as required by the claims) “below the base of the
 user’s fingers” (as required by H&B) without the “stem” portion of the T-brace piercing through the
 user’s hand.

The “undulations” and “protuberances” dependent claims of the ‘091 Patent further evidence the impossibility of H&B’s construction. *See* ‘091 Patent, 5:22-31 (claims 2 and 3). A member that “has a plurality of undulations *designed to accommodate the user’s fingers* and a plurality of protuberances *designed to fit between the user’s fingers*” cannot be retained below the base of the fingers as posited by H&B. *See id.* Accordingly, H&B’s construction of “adjacent” to mean “below” should not be adopted.

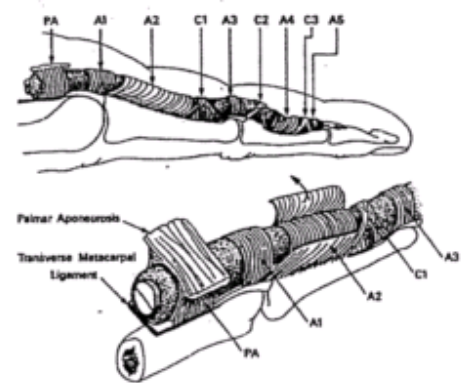
If any construction of the phrase is needed, the phrase “adjacent to the base of the of the user’s fingers” should be construed to mean “near the proximal phalanx A2 pulley region of the user’s fingers.” Similar to the medical reference location provided for the phrase “in a gap,” the proximal phalanx A2 pulley region of the user’s fingers identifies the location of a user’s hand adjacent to the base of the user’s fingers. Such a construction is consistent with medical references outlined in Figure 1 of the ‘091 Patent and the specification related thereto. *See* ‘091 Patent, Fig. 1, 2:29-42. Figures from medical encyclopedias and journals are provided to illustrate this location in the hand in relation to Figure 1.



(‘091 Patent, Fig. 1.)



(DOYLE MD (*see citation below*)).



(NETTER MD (*see citation below*)).

Dolye MD. Anatomy of the finger flexon tendon shealth and pulley system. J. HAND SURG. 1988; 13A:473-484; FRANK H. NETTER MD., ATLAS OF THE HUMAN ANATOMY 463 (Saunders Elsevier

4th ed. 2006) (1989).⁹ In sum, the phrase “adjacent to the base of the user’s fingers” reflect the plain and ordinary meaning intended by the claims, and as such, no construction of the phrase is required. To the extent that any construction is required, the phrase “adjacent to the base of the of the user’s fingers” should be construed to mean “near the proximal phalanx A2 pulley region of the user’s fingers.”

2. The phrase “base of the of the user’s fingers” does not require construction.

Similar to “adjacent to the base of the user’s fingers,” the phrase “base of the user’s fingers” does not require construction. Indeed, H&B offered no construction for the phrase “base of the user’s fingers” in its construction of “adjacent to the *base of the user’s fingers*.” See Section III(C)(1) (H&B construes “adjacent to the *base of the user’s fingers*” to simply mean “below the *base of the user’s fingers*”). This suggests that H&B understands the term “base of the user’s fingers” to have a plain and ordinary meaning.¹⁰ As such, it does not require construction.

To the extent that “base of the user’s fingers” requires construction, it must be consistent with the construction of “adjacent to the *base of the user’s fingers*.” See *Wilson Sporting Goods Co. v. Hillerich & Bradsby Co.*, 442 F.3d 1322, 1328 (Fed. Cir. 2006) (“the same terms . . . should have the same meaning unless it is clear from the specification and prosecution history that the terms have different meanings at different portions of the claims.”) (internal citations and quotations omitted). As discussed in detail in Subsection III(C)(1) *supra*, the construction of the phrase “adjacent to the base of the user’s fingers,” to the extent it is required, should mean “near the proximal phalanx A2 pulley region of the user’s fingers.” Accordingly and for the same reasons, any construction of the phrase “the base of the user’s fingers” should mean “at the proximal phalanx A2 pulley region of the user’s fingers.”

3. The phase “includes a plurality of sub-members” does not require construction.

H&B seeks the convoluted construction of the phase “includes a plurality of sub-members”

⁹ Attached as Exhibit 5 and 6, respectively, to McHugh’s Evidence.

¹⁰ McHugh notes that in all of H&B’s other constructions, repeated terms are – unlike here – consistently construed. See e.g., Subsection III(B)(1) (H&B construes “member” to mean, in part, “grip”); Subsections III(C)(3-4) (H&B construes “member” to mean “grip”).

1 to mean “includes two or more small grips incorporated into the long and narrow grip” in a further
 2 attempt to establish its position that gloves with pads at the base of the fingers do not infringe the
 3 ‘091 Patent. The phrase “includes a plurality of sub-members” appears in claim 12 of the ‘091
 4 Patent. No construction is required because the phrase reflects the plain and ordinary meaning
 5 understood by one of ordinary skill in the art.

6 The term “plurality” is a well-known term of art to mean “two or more.” *See York Prods.,*
 7 *Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575 (Fed. Cir. 1996) (“The term
 8 [plurality] means, simply, ‘the state of being plural.’”). On its face, it appears that H&B’s
 9 construction adopts this plain and ordinary meaning and similarly does not offer an alternative
 10 meaning for the term “includes” in its construction. Accordingly, the crux of the dispute between
 11 the parties appears to be H&B’s construction of the term “sub-members” to mean “small grips
 12 incorporated into the long and narrow grip.”

13 H&B’s construction is wrong for several reasons. As an initial matter, the term “member”
 14 cannot be construed to mean “grip.” *See infra*, Subsection III(A)(1) (discussing how construing
 15 “member” to mean “grip” improperly results in optional claim limitations). Second, the prefix
 16 “sub” does not suggest the construction of “sub-members” to mean “small grips incorporated into
 17 the long and narrow grip.” Indeed, “sub” simply means subordinate. *See e.g., American Heritage*
 18 *Dictionary* 1721 (4th ed. 2000) (“sub” defined as “subordinate”); *Webster’s Third New*
 19 *International Dictionary, Unabridged*, Merriam-Webster (2002) (“sub” defined as “subordinate
 20 portion of”); *Webster’s Encyclopedic Unabridged Dictionary of the English Language* 867 (1996)
 21 (“sub” defined as “subordinate”); *New Oxford American Dictionary of English* 1441 (2nd ed. 2005)
 22 (“sub” defined as “of a subordinate nature”).¹¹

23 Third, the claims and specification further abhor H&B’s construction. With reference to
 24 sub-member embodiments, the specification states:

25 FIG. 5B shows a glove 54 where grip 20 is broken up into four small grips 56a-d
 26 that provide support to one finger each. This is accomplished by incorporating
 27 four grips (as small elongated members 56a-d) into each of the four fingers of a
 28 glove near the base of the fingers, as shown.

¹¹ Attached as Exhibit 4 to McHugh’s Evidence.

1 '091 Patent, 4:41-44. The term "incorporating" refers to how sub-members are incorporated into a
 2 retainer – in the above-referenced embodiment, a glove – **not** how sub-members are incorporated
 3 into one large member. Indeed, claim 13 expressly claims this embodiment:

4 A hand grip as in claim 12 [i.e., the sub-member embodiment], wherein:
 5 the retainer is a glove configured to secure around the user's fingers and
 6 including an attachment to retain the elongated member in a position adjacent to
 7 the base of the user's fingers.

8 '091 Patent, 6:4-8 (claim 13). The term "incorporating" does not otherwise appear in the '091
 9 Patent.

10 Accordingly, the phrase "including a plurality of sub-members" does not require
 11 construction by the Court. If a construction is required, McHugh offers the plain and ordinary
 12 meaning of the phrase as it is understand in the art; the phrase should be construed to mean:
 13 "includes two or more sub-members."

14 **4. The phrases "retain the member" and "configured to fit" do not require
 15 construction.**

16 The phrase "configured to fit" does not require construction because it is a term that would
 17 easily understood by one of ordinary skill in the art. As evidenced by McHugh's alternative
 18 construction of the phrase to alternatively mean "designed to fit," the parties agree about what an
 19 alternative construction of the phrase might be; however, McHugh contends that no alternative
 20 construction is required when the plain and ordinary meaning is clear on its face. Indeed, claim
 21 construction is not meant to be an academic exercise in which a court pronounces the meaning of
 22 every aspect of a patent claim at issue. Instead, "claim construction is a matter of resolution of
 23 disputed meanings and technical scope, to clarify and when necessary to explain what the patentee
 24 covered by the claims, for use in the determination of infringement. It is not an obligatory exercise
 25 in redundancy." *NTP v. Research in Motion, Ltd.*, 418 F.3d 1282, 1311 (Fed. Cir. 2005), *cert.*
 26 *denied*, 126 S. Ct. 1174 (U.S. 2006) (*citing U.S. Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554,
 27 1568 (Fed. Cir. 1997)) (emphasis added) . In claim 1 alone, H&B has requested the Court to
 28 construe 50 of the 105 words in the claim. Many of terms proposed by H&B– including "designed
 to fit" and as elsewhere noted in this brief – do not require construction.

The phrase "to retain the member" similarly does not require construction. Like

1 “configured to fit,” construing this phrase is merely an exercise in redundancy. *See NTP*, 418 F.3d
 2 at 1311. If any construction is required, it must be consistent with and compelled by the claims and
 3 intrinsic evidence. Unlike H&B’s construction of the phrase to mean “to hold or secure the grip,”
 4 McHugh’s alternative construction of the phrase “to retain the member” to mean “maintain the
 5 position of the member in the user’s hand” is supported by the intrinsic evidence.

6 The specification describes the retainer’s ability to retain the member as follows: “A
 7 flexible elastic band retainer 26 is provided to attach to the user’s finger so that the grip 20 *will*
 8 *remain in the proper position.*” ‘091 Patent, 2:55-57 (emphasis added). The specification also
 9 describes how certain preferred retainer embodiments, such as a glove with an attachment, retain
 10 the member:

11 Another embodiment is depicted in FIG. 5A, where a glove 50 includes an
 12 attachment 52 for a hand grip 20. Glove 50 is constructed so that material is
 13 formed over the gap near the base of fingers 14. This material includes
 14 attachments 52a and 52b *to hold grip 20 in place over the base of the fingers.*

15 ‘091 Patent, 4:31-36 (emphasis added).

16 Accordingly, to the extent that any construction is required, the phrase “to retain the
 17 member” should be construed to mean: “maintain the position of the member in the user’s hand.”

18 IV. CONCLUSION

19 For the foregoing reasons, McHugh respectfully request that the Court adopt his proposed
 20 constructions for the disputed terms of the ‘091 Patent.

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